REMARKS

Claims 1 to 10 continue to be in the application.

Claim 11 stands withdrawn from consideration.

New claims 12 to 18 are being introduced.

New claim 12 is based on the language of claims 2, 9, and 10.

New claim 13 is based on the language of claim 3.

New claim 14 is based on the language of claim 4.

New claim 15 is based on the language of claim 5.

New claim 16 is based on the language of claim 6.

New claim 17 is based on the language of claim 7.

New claim 18 is based on the language of claim 8.

The Office Action refers to Election /Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species I, drawn to a device for measuring thickness incorporating a magnetic belt, as shown in Figures 1 & 2.

Species II, drawn to a device for measuring thickness incorporating a magnetic disk.

Applicant selects Group I. Claims 1 to 10 are readable on group I.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Applicant selects Group I. Claims 1 to 10 are readable on group I.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. The claims are deemed to correspond to the species listed above in the following manner:

Claims 1-10 corresponds to Species I.

Claim 11 corresponds to Species II.

The following claim(s) are generic:

none.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding

special technical features for the following reasons: A magnetic belt is operated in a dissimilar manner than a magnetic disk.

4. During a telephone conversation with Mr. Kasper on 12/5/6 a provisional election was made without traverse to prosecute the invention of Species I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 11 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

a. Applicant confirms the election of group I, claims 1 to 10.

The Office Action refers to Claim Objections.

5. Claims 1, 3,6, 8,10, & 11 stand objected to because of the following informalities:

In claim 1, line 1, "iength" should be —length—.

In claim 3, line 2, "an a" should be —in a--; "an or" should be —on or—.

In claim 6, line 2, "an" should be —on™.

In claim 8, line 1, "9" should be —7—; in line 2 & 3, "an" should be —on™.

In claim 10, line 2, "an" should be —on—.

In claim 11, line 5, "an" should be —on—; line 10, "an" should be —on—.

Appropriate correction is required.

Applicant thanks the Examiner for pointing out the objections, which are being corrected in the present amendment.

The Office Action refers to Claim Rejections - 35 USC § 112.

7. Claims 1-10 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. With reference to claims 1 & 2, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu,* 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions *of Ex parte Steigewald,* 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall,* 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche,* 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1 recites the broad recitation "A method for measuring the thickness and/or length of objects having a solid or gel-like consistency", and the claim also recites "especially pharmaceutical objects such as

tablets, pill, or oblongs"; while claim 2 recites the broad recitation "A device for measuring the thickness and/or length of objects having a solid or gel-like consistency", and the claim also recites "especially pharmaceutical objects such as tablets, pill, or oblongs" which are the narrower statements of the range/limitations.

Applicant has stricken the objectionable language from the claims 1 and 2.

Claims 3-10 stand rejected due to their dependency upon a rejected base claim.

9. Claim 1 provides for the use of the method for measuring thickness, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

The objectionable language has been cancelled from claim 1.

*The Office Action refers to Claim Rejections - 35 **USC § 101.***

10. Claim 1 stands rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i. E. results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki,* 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner,* 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

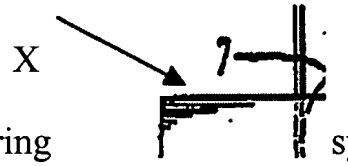
The objectionable language is being cancelled from claim 1.

The Office Action refers to Claim Rejections - 35 USC § 103.

12. Claims 1-5 & 7-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gruhler (U.S. Patent 4924598) in view of Kaburagi et al. (U.S. Patent 5434602).

The rejection is respectfully traversed.

With reference to claims 1-5, 9, & 10 Gruhler discloses a device and method of using for measuring the thickness of objects comprising a base (30) from which a column (1) rises vertically with a placement surface for the object (X, see below),



whereby a length-measuring system is arranged along the column comprising a continuously looped belt (5) mounted along the column on a carriage (3) (Figure) along a groove/guide (2) & rollers (6,7) (Figures 1 & 10); moved along the column by means of an electric motor (10) (Figure 2), while a projecting arm (4) engages the belt being able to accompany the movement of the belt for making contact with the object to be measured (Figure 1).

Applicant respectfully disagrees.

The reference Gruhler fails to teach how a thickness or a length of a tablet could be measured with the construction according to the Gruhler reference. The reference Gruhler suggests possibilities for realizing an adjustable measurement force, but does not teach a determination of a thickness or of a height.

Gruhler does not disclose the belt is magnetic and provided with a plurality of pole pitches, with a stationary magnetic field sensor having an electric evaluation circuit on the base.

Kaburagi et al. discloses a recording apparatus with a magnetic linear encoder in the embodiment shown in Figure 60 with a looped scale (733) with pole pitches (col. 28 line 27) sensed by a stationary magnetic sensor (737) and a counting circuit (739) in order to read information on said scale without hindering any other component (col. 28 lines 36-40) and detect the speed and position of the carriage (732) (col. 28 lines 48-50). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the pole pitches, disclosed by Kaburagi et al. to the belt, and add the sensor and counting circuit disclosed by Kaburagi et al. to the base disclosed by Gruhler in order to not only detect that motion is occurring up or downward as Gruhler discloses (col. 6 lines 51-56), but that an absolute position value is known.

The reference Kaburagi et al. is concerned with a determination of a position and a speed of a print head with the aid of a magnetic scale, which is formed as a magnetic band according to Figure 61 as well as column 28, line 21 to column 29 line 2 and which can be formed into an endless loop. However this reference Kaburagi et al. does not show a possibility of thickness measurement or length measurement of objects, and the subject matter of this reference Kaburagi et al. is neither furnished nor suitable for such measurements. In summary, the reference Kaburagi et al. therefore belongs to a completely different kind of construction as compared to the claims of the present application, such that a person of ordinary skill in the art will not consider the reference Kaburagi et al. and will combine the Kaburagi et al. Reference with the Gruhler reference.

Reconsideration of all outstanding rejections is respectfully requested.

All claims as presently submitted are deemed to be in form for allowance and an early notice of allowance is earnestly solicited.

Respectfully submitted,
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